



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

m<sup>y</sup>

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,930	06/18/2002	Jiri Babej	60174-028	8742

7590 01/22/2004

Gregory D DeGrazia  
Howard & Howard Attorneys  
The Pinehurst Office Center Suite 101  
39400 Woodward Avenue  
Bloomfield Hills, MI 48304-5151

EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
----------	--------------

3726

8

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/019,930

Applicant(s)

BABEJ, JIRI

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 32-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-25 is/are rejected.
- 7) ☒ Claim(s) 26-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of claims 23-31 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "220" has been used to designate both nose-like projections and bulge-like projections. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 219. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 221, 235, 262, 316, 325, 419, 436. A proposed drawing correction or

corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4), and is not written on lines that are 1 ½ or double spaced in accordance with 37 CFR 1.52 (b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "**said**," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The disclosure is objected to because of the following informalities: On page 9, line 25, it is suggested to change "276" to - -236- -; On page 12, lines 22 and 26, it is

suggested to change "220" to - -219- -; On page 15, line 7, it is suggested to change "218" to - -318- -, line 12, change "316" to - -318- -; On page 16, line 8, it is suggested to change "282" to - -285- -, lines 21 and 23, change "arched" to - -dome-like- -; On page 17, line 3, it is suggested to "220" to - -219- -, line 5, change "arched" to - -dome-like- -, line 9, change "270" to - -272- -, line 24, insert - -region- - after "end"; On page 18, line 1, change "220" to - -219- -; On page 21, line 16, change "6" to - -6A- -, line 20, change "an inner bore" to - -plunger passage- -; On page 25, line 17, change "6" to - -6A- -, line 23, delete "403" and after "plunger" insert - -403- -, line 24, change "402" to - -403- -; On page 27, line 6, change "466" to - -406- -. Appropriate correction is required.

### ***Claim Objections***

8. Claims 23-25 are objected to because of the following informalities: In claim 23, lines 3-5, it is suggested to delete "in particular in accordance with a method in accordance with any one of the claims 1 to 12 and/or using a die in accordance with at least one of the claims 13 to 22," since claims 23-31 are only directed to the functional element; In claim 24, line 5, it is suggested to insert - -a- - after "least"; In claim 25, line 3, it is suggested to change "the" in its first occurrence to - -a- -. In addition, it is suggested to remove all of the reference characters from the claims. Appropriate correction is required.

9. Claims 26-31 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. Claim 24 recites the limitation "the end face" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 25 recites the limitation "the open end face" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 0028019 A1.

EP discloses a functional element for attachment to a sheet metal part (10), wherein the functional element comprises a shaft part (1) and a head part (2), wherein the functional element is designed for a riveted joint to a panel member , in particular to a sheet metal part (10) in that at least the head part is made hollow and preferably has

at least substantially the same outer diameter as the shaft part. See pages 3 – 5, and Figures 1 and 3 for further clarification.

Note that “for attachment in a liquid tight or gas-tight manner”, is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

16. Claims 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ladouceur (5,868,535).

Ladouceur discloses a functional element (20) for attachment to a sheet metal part (52), wherein the functional element comprises a shaft part (28) and a head part (22), wherein the functional element is designed for a riveted joint to a panel member, in particular to a sheet metal part (52) in that at least the head part is made hollow and preferably has at least substantially the same outer diameter as the shaft part. The hollow head part (22) has a preferably at least substantially partly spherical rounded shape (34) at its end remote from the shaft part (28), with the rounded shape ending in particular in at least a substantially circular aperture (not labeled) at and face which is preferably arranged in a plane perpendicular to the longitudinal axis of the functional element (20). The open end face (32) at the head part (22) of the functional element

(20) is rounded so as not to damage the sheet metal part (52). See column 4, line 56 – column 5, line 65, and Figures 1-7 for further clarification.

Note that "for attachment in a liquid tight or gas-tight manner", is a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### **Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited on the attached PTO-892 are cited to show fasteners (e.g. bolts, nuts, rivets).

18. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

19. If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc.,



Art Unit: 3726

requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

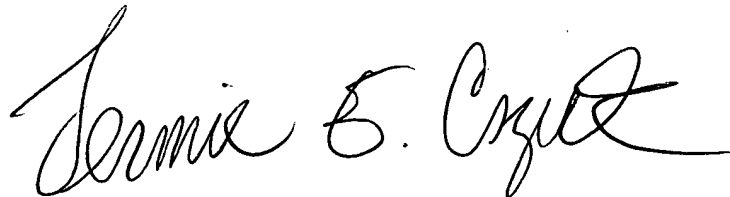
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 703-305-0126. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.


21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Listed below are a few helpful numbers and web address for The United States Patent and Trademark Office.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404 or (703) 305-8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257
Information Help Line	(800) 786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov">http:// www.uspto.gov</a>



JC   
January 15, 2004